

REMARKS

I. STATUS OF CLAIMS

Claims 46, 47, 49 to 51, 54, 56, 58 and 60 to 62 are currently pending in the application.

No claim has been amended in this paper.

Reconsideration is respectfully requested in light of the following remarks.

II. THE REJECTIONS

Applicants priority claim to an earlier application 09/082,038 (038) (now Patent No. 6,872,535) was denied under 35 U.S.C. §120 as that all the claims of the present application allegedly contain subject matter that is not sufficiently disclosed in the 038 application.

Claims 46, 47, 49 to 51, 54, 56, 58 and 60 to 62 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by WO 99/59722 to Stein *et al.* (' Stein).

Claims 46, 47, 49 to 51, 54, 56, 58 and 60 to 62 were rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement with respect to the limitation of 'solid phase supports in the columns are substantially aligned .

In view of the following remarks, reconsideration and withdrawal of the priority denial and the rejections are requested respectfully.

III. ARGUMENTS

The priority claim of the present application as a division to an earlier application No. 09/082,038 ('038) (U.S. patent No. 6,872,535; the '535 patent) has been denied under 35 U.S.C. 120 (*see* page 3 of the Action). The Examiner alleges that there is no sufficient support in the '038 application with respect to the limitation of 'solid phase supports in the columns are substantially aligned set forth in Claim 46 (and also in its dependent claims) of the present application. The Examiner comments that only tube-type supports being substantially aligned are disclosed (*see* also page 4 of the Action). Applicants disagree.

Applicants respectfully submit that the '038 application has a sufficient disclosure on the limitation of 'the solid phase supports in the columns are substantially aligned. In contrast to the Examiner's allegation, the '038 application not only discloses tube-type supports as a species being substantially aligned (lines 11 to 17 of column 3, and lines 55 to 57 of column 16 of the '535 patent), but also discloses that solid supports as a genus being substantially aligned. Such disclosure with respect to supports of various types can be found throughout the '038 application (*see* lines 17 to 23 of column 3, and also Figures 13 to 17 of the '535 patent).

Further, Applicants respectfully submit that the drawings of the '038 application supports generally a recitation in Claim 46 that the supports being substantially aligned have apertures with rods extending through (*see* Figures 17 and 29 of the '535 patent). It is a longestablished and well-settled rule that 'drawings alone may provide a written description of an invention as required by § 112. *Vas-cath v. Mahurkar*, 935 F.2d 1555, 1565 (Fed. Cir. 1991); *In re Heinle*, 342 F.2d 1001, 145 U.S.P.Q. (BNA) 131 (1965). With regard to the question whether a drawing of a species is sufficient to support a claimed genus, the *Vas-cath* court stated expressly that the

proper test is to determine whether the drawing conveys the claimed invention to those of ordinary skill with reasonable clarity. 935 F.2d at 1566. Here, Figures 17 and 29 show that tube-type supports (as a species among others) being substantially aligned have apertures with rods extending through. One skilled in the art will agree that Applicants have clearly conveyed through Figures 17 and 29 a generic limitation that the supports being substantially aligned can have apertures with rods extending through.

For all the foregoing reasons, Applicants respectfully submit that there is sufficient support in the '038 application for the generic solid-phase supports being substantially aligned. Therefore, all the claims are entitled to claim priority to the parent '038 application. Accordingly, reconsideration and withdrawal of the denial on Applicants' priority claim to the '038 application are requested respectfully.

All the pending claims of the present application have been rejected under 35 U.S.C. §102(b) as allegedly being anticipated by WO 99/59722 ('Stein'). However, because all the claims are entitled to claim the priority date of May 20, 1998 (which is the filing date of the '038 application), the Stein publication, which was published on November 25, 1999, cannot serve as a §102(b) prior art to the claims of the present application. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. §102(b) are requested respectfully.

All the pending claims have also been rejected under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. In particular, the Examiner alleges that the

limitation of 'solid phase supports in the columns are substantially aligned' set forth in Claim 46 constitutes a new matter. Applicants disagree.

Applicants respectfully point out that the disclosure and figures of the '038 application and those of the present application are essentially the same. For the same reasons as previously discussed, Applicants respectfully submit that the limitation is fully supported in Applicants specification (*see* lines 5 to 14 of page 5, lines 22 to 24 of page 30, and also Figures 13 to 17, 21 & 29 of the present application). Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, first paragraph, are requested respectfully.

IV. CONCLUSIONS

Applicants respectfully submit that this application is now in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested.

The Commissioner is hereby authorized to charge the fee required and any additional fees that may be needed to Deposit Account **19-5425** in the name of Synnestvedt & Lechner LLP.

Respectfully submitted,

Dated: June 23, 2008

s/Weiyang Yang/
Weiyang Yang
Reg. No. 61,637

Synnestvedt & Lechner LLP
1101 Market Street
Suite 2600
Philadelphia, PA 19107-2950
Telephone: (215) 923-4466
Facsimile: (215) 923-2189

P:\S drive - Clients\S\SANOFI-AVENTIS\Patents\P26015 US1\Reply to OA January 24, 2008-draft.doc